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UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/997,543	SCHERZER, HELMUT
	Examiner	**Art Unit**	
	Bijendra K. Shrestha	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on <u>01 May 2007</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-15 are presented for examination. After careful consideration of applicant's arguments, the rejection of claims 1-15 is maintained using the existing references and new references as set forth in detail below. Applicant's arguments with respect to these claims have been considered but are moot in view of the new ground(s) of rejection.

The Examiner respectfully disagrees the Applicant argument against "Double Patenting" rejection against U.S. Patent No. 6, 711, 685. As per claim 1-4, 7 and 10-15 of instant application, claims 1-15 of '685 patent teaches using a counter for counting the uses of protected data element (age information), setting counter to starting value, increasing counter value, resetting counter value, blocking use of data on reaching a threshold maximum, an event consisting one or more events, secret information is a code for encoding data, and secret information is a secret function for executing safety relevant operation on a **chip card**. Although the conflicting claims are not identical, they are not patentably distinct from each other. Examiner, therefore, maintains double patenting rejections for claims 1-4, 7 and 10-15 of the instant application and requests to issue terminal disclaimer to overcome the rejection.

Drawings

2.   The Examiner acknowledge acceptance of drawings submitted on 05/01/2007.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Curry et al., U.S. Patent No. 5,949,880 (reference A in attached PTO-

892) in view of Kingdon et al., U.S. Patent No. 6,615,193 (reference B in attached PTO-

892).

5.   As per claim 1, Curry et al. teach an electronic purse data carrier for performing

monetary transactions, comprising

        a storage means for storing one or more payment units each having a respective

monetary value (see Fig. 2; Fig. 5, step Y12; column 3, lines 56-65; where monetary

data are stored in memory 202 of data carrier);

        each of said payment units comprising

        an age information for delimiting use of the payment unit (see Fig. 2; column 3,

lines 66-67; column 4, lines 1-4; where counter 206 in data carrier keep track of number

of transaction performed delimiting use of payment unit); and

        Curry et al. <u>do not teach that each of said payment units having a respective</u>

<u>unique payment unit-ID</u>.

Kingdon et al. teach that each of said payment units having a respective unique

payment unit-ID (see Fig. 3-5; column 5, lines 26-57).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to include payment units having a respective unique

payment unit-ID of Curry et al. because Kingdon et al. teach that incorporating above

features enables to detect fraud and provides means to assess levels of fraudulent

exposure (Kingdon et al., column 3, lines 2-7).

6.   As per claim 2, Curry et al. in view of Kingdon et al. teach claim 1 as described

above.

Curry et al. further teach the carrier, in which

said age information reflects the extent of transactional use of the respective

payment unit (see column 3, lines 66-67; column 4, lines 1-4).

7.   As per claim 3, Curry et al. in view of Kingdon et al. teach claim 2 as described

above.

Curry et al. further teach the carrier, in which

said age information represents a date information (see Fig. 2; column 4, lines 2-

5; where timer 208 provide timestamp (date) information).

8.   As per claim 4, Curry et al. in view of Kingdon et al. teach claim 3 as described

above.

Curry et al. further teach the carrier comprising

a processor for read and /or write access to said storage means, and means for

updating said age information whenever a transaction has been performed with a

respective payment unit (see Fig. 2; column 4, lines 4-6; where memory controller (processor) 204 controls read and write access to memory 202 and updates transaction counter and timer data to the memory).

9.   As per claim 10, Curry et al. teach a banking terminal device for accessing purse data stored in a storage means of an electronic purse data carrier for performing monetary transactions, the storage means storing one or more payment units each having a respective monetary value (see Fig. 1; Automatic Teller machine, 112), characterized by each of said payment units comprising

an age information evaluable for delimiting the use of the payment unit (see Fig. 4, step X1; where transaction counter count provides age information for delimiting the use of the payment unit), and

the banking terminal device comprising:

implemented program means for verifying said age information (see Fig. 1; column 3, lines 14-15; where microprocessor device verifies age information in the step Y6 in Fig. 5), and

implemented program means for resetting said age information after successful verification of said payment unit (see Fig. 5, step Y13; column 9, lines 11-12; column 6, lines 31-43); and

Curry et al. do not teach each of said payment units having a respective unique payment unit-ID.

Kingdon et al. teach each of said payment units having a respective unique

payment unit-ID (see Fig. 3-5; column 5, lines 26-57).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to include payment units having a respective unique

payment unit-ID of Curry et al. because Kingdon et al. teach that incorporating above

features enables to detect fraud and provides means to assess levels of fraudulent

exposure (Kingdon et al., column 3, lines 2-7).

10.   As per claim 11, Curry et al. teach a trading transaction device comprising:

means for entering a trading price, an input interface for a first mobile electronic

purse data carrier for performing monetary transactions (see Fig. 1; column 2, lines 38-

45; column 7, lines 40-44; where microprocessor base device 104 is trading device),

the carrier comprising

a storage means for storing one or more payment units each having a respective

monetary value, characterized by each of said payment units comprising an age

information evaluable for delimiting the use of the payment unit (see Fig. 6; column 5,

lines 63-67; column 6, lines 4-22, 25-30; where secure model 108 used by multiple

service providers; the data objects stored in secure module include transaction count,

encryption keys, money amounts, date/time stamps etc.; column 8, lines26-29;where

insecure portable module could be another secure module similar to the secure

module);

a connective interface to second such carrier (see Fig. 1; column 2, lines 45-68;

column 8, lines 26-29; where 106 forms a connective interface between portable

module 102 and secure microprocessor based devices (credit carrier) 108 through

microprocessor device104); and

means for updating the storage means of both carriers according to the

transaction to be traded (see Fig. 6; where microprocessor based device updates

monetary values and transaction counts as described in steps Y7 to Y13 in Fig. 5;

column 9, lines 10-16).

Curry et al. do not teach that each of said payment units having a respective

unique payment unit-ID.

Kingdon et al. teach that each of said payment units having a respective unique

payment unit-ID (see Fig. 3-5; column 5, lines 26-57).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to include payment units having a respective unique

payment unit-ID of Curry et al. because Kingdon et al. teach that incorporating above

features enables to detect fraud and provides means to assess levels of fraudulent

exposure (Kingdon et al., column 3, lines 2-7).

11.   Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Curry et al., U.S. Patent No. 5,949,880 (reference A in attached PTO-892) in view of

Kingdon et al., U.S. Patent No. 6,615,193 (reference B in attached PTO-892) further in

view of Teicher (reference AA in IDS submitted by the applicant).

12.   As per claim 5, Curry et al. in view of Kingdon et al. teach claim 4 as described

above.

Curry et al. further teach means for transferring a respective age information from

said parent unit to the plurality of child payment units, and means for generating a

resulting age information for said joined payment unit according to a predetermined rule

(see Fig. 5, steps Y10-Y13; column 9, lines 3-12; where age information is transferred

from ATM 112 to portable module (data carrier); Examiner interprets process is

transferring age information between card to card is essentially same as that from ATM

to cards as explained in Teicher reference below).

Curry et al. in view of Kingdon et al. do not teach means for splitting a parent

payment unit having a given non-minimum parent monetary value into a plurality of child

payment units, each having a child monetary value smaller than the parent value, the

sum of child monetary values being the same as the parent monetary value, and means

for joining a plurality of single payment units having a given total monetary value into a

joined payment unit having a corresponding same monetary value.

Teicher teaches means for splitting a parent payment unit having a given non-

minimum parent monetary value into a plurality of child payment units, each having a

child monetary value smaller than the parent value, the sum of child monetary values

being the same as the parent monetary value, and means for joining a plurality of single

payment units having a given total monetary value into a joined payment unit having a

corresponding same monetary value (see column 26, lines 59-67; column 27, lines 1-

10; where card to card transaction feature allows transfer of electronic coins through

transaction device (essentially similar to purse-to-drawer interface) while maintaining

the integrity of the system).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to allow splitting a parent payment unit having a given non-

minimum parent monetary value into a plurality of child payment units of Curry et al. in

view of Kingdon et al. because Teicher teaches that splitting a parent payment unit

having a given non-minimum parent monetary value into a plurality of child payment

units enable person-to-person transactions (Teicher, column 26, lines 61-63).

13.   As per claim 6, Curry et al. in view of Kingdon et al. further in view of Teicher

teach claim 5 as described above.

Curry et al. in view of Kingdon et al. do not teach means for generating a

patching pattern for splitting and/or joining payment units according to storage

requirements present on the carrier.

Teicher teaches means for generating a patching pattern for splitting and/or

joining payment units according to storage requirements present on the carrier (see

column 27, lines 1-9; where card-to-card transaction are limited according to the

electronic coins stored in both cards).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to allow means for generating a patching pattern for

splitting and/or joining payment units according to storage requirements present on the

carrier of Curry et al. in view of Kingdon et al. because Teicher teaches that means for

generating a patching pattern for splitting and/or joining payment units according to

storage requirements present on the carrier would limit card-to-card payment according to the amount actually stored in both cards (Teicher, column 27, lines 4-6).

14.   As per claim 7, Curry et al. in view of Kingdon et al. further in view of Teicher teach claim 5 as described above.

Curry et al. teach the carrier comprising

means for excluding a payment unit from an intended split or join process if said payment unit has exceeded a predetermined change threshold age level (Curry et al., Fig. 4, steps X6 and X7; column 7, lines 50-54).

15.   As per claim 8, Curry et al. in view of Kingdon et al. further in view of Teicher teach claim 7 as described above.

Curry et al. in view of Kingdon et al. do not teach a plurality of payment units of different monetary value.

Teicher teaches a plurality of payment units of different monetary value (see Fig. 26, column 2, lines 49-53).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to allow a plurality of payment units of different monetary value Curry et al. in view of Kingdon et al. because Teicher teaches that allowing a plurality of payment units of different monetary value would minimize storage requirements for electronic coins and provide signal for security leak, if there is forbidden repetition or out-of-range instances (Teicher, column 2, lines 55-65).

16.   As per claim 9, Curry et al. in view of Kingdon et al. teach claim 1 as described above.

Curry et al. in view of Kingdon et al. do not teach means for storing personal

identification Data associated with one or more payment units.

Teicher teaches means for storing personal identification data associated with

one or more payment units (see column 27, lines 36-44).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to allow means for storing personal identification data

associated with one or more payment units of Curry et al. in view of Kingdon et al.

because Teicher teaches that allowing means for storing personal identification Data

associated with one or more payment units would enable to identify unused electronic

bills upon the expiration date (Teicher, column 27, lines 51-51).

17.   Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Curry et al., U.S. Patent No. 5,949,880 (reference A in attached PTO-892) in view of

Wallace, U.S. Patent No. 5,988,497 (reference C in attached PTO-892).

18.   As per claim 12, Curry et al. teach a method for managing electronic payments

with an electronic purse data carrier, comprising the steps of:

checking for each transaction if age information of a payment unit being part of

the transaction has matching transaction count, and restricting the use of a payment

unit with not matched transaction counter (see Fig. 1; Fig. 4, step X6; column 7, lines

50-54; where transaction occurs only if transaction count (age information) matches).

Curry et al. do not teach checking for each transaction if age information of a

payment unit being part of the transaction has exceeded a predetermined transaction

age threshold level, and restricting the use of a payment unit with an exceeded

transaction age threshold level.

Wallace teach checking for each transaction if age information of a payment unit

being part of the transaction has exceeded a predetermined transaction age threshold

level, and restricting the use of a payment unit with an exceeded transaction age

threshold level (see Fig. 1, step 110 and 118; column 2, lines 4-29; column 5, lines 23-

34).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to include checking for each transaction if age information

of a payment unit being part of the transaction has exceeded a predetermined

transaction age threshold level, and restricting the use of a payment unit with an

exceeded transaction age threshold level of Curry et al. because Wallace teaches that

incorporating above features enables deter fraudulent use of credit card (Wallace,

column 27-33).

19.   As per claim 13, Curry et al. in view of Wallace teach claim 12 as described

above.

Curry et al. further teach the method comprising the steps of:

using an age counter mechanism for checking the age information of a payment

unit (see Fig. 4, step X1; Fig. 5, step Y1; transaction count (age information) is checked

by transaction counter 206 in Fig. 2),

the counter mechanism being

implemented by encrypting a target number X, by successively applying, a total

of m-times, a private key to a source key and the respective application result, said

source key representing unused age information (see Fig. 4, step X1 and X2; column 7,

lines 20-27),

said target number X being the result of applying, a total of n-times, a public key

to said source key, on each payment transaction applying said public key on said age

information yielding a respective current age data (see Fig. 4, step X4; column 7, lines

40-44), and

checking for each transaction if the age information of a payment unit being part

of the transaction corresponds to the target number X (see Fig. 4, step X5 and X6).

20.   As per claim 14, Curry et al. in view of Wallace teach claim 13 as described

above.

Curry et al. further teach the method, in which

repetitive application of the public key to said source key, and the respective

application results yields a monotone varying function with a transaction age threshold

value corresponding to said target number X (see Fig. 4, steps X4-X6; where public key

repetitively applied to source key (encrypted data packet) as transaction counter is

updated after each successful transaction; transaction is permitted if and only if counter

number matches).

21.   As per claim 15, Curry et al teach computer program product stored on a

computer usable medium comprising computer readable program means for causing a

computer to manage electronic payments with an electronic purse data carrier, where

the carrier stores age information corresponding to payment units stored thereon, the

computer program product causing the computer to perform the steps of:

checking for each transaction if age information of a payment unit being part of

the transaction has matching transaction count, and restricting the use of a payment

unit with not matched transaction counter (see Fig. 3, steps X6 and X7; column 7, lines

50-54; Fig. 5; stepsY6 and Y7; column 8, lines 59-65; the secure model is programmed

to check matching of its counter transaction number with decrypted data's transaction

counter number and transaction proceeds forward if and only if they are exact match, to

make sure that data received is not counterfeit data).

Curry et al. do not teach checking for each transaction if age information of a

payment unit being part of the transaction has exceeded a predetermined transaction

age threshold level, and restricting the use of a payment unit with an exceeded

transaction age threshold level.

Wallace teach checking for each transaction if age information of a payment unit

being part of the transaction has exceeded a predetermined transaction age threshold

level, and restricting the use of a payment unit with an exceeded transaction age

threshold level (see Fig. 1, step 110 and 118; column 2, lines 4-29; column 5, lines 23-

34).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the

time the invention was made to include checking for each transaction if age information

of a payment unit being part of the transaction has exceeded a predetermined

transaction age threshold level, and restricting the use of a payment unit with an

exceeded transaction age threshold level of Curry et al. because Wallace teaches that

incorporating above features enables deter fraudulent use of credit card (Wallace,

column 27-33).

Conclusion

22.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosures. The following are pertinent to current invention, though not

relied upon:

Bellare et al. (U.S. Patent No. 5,999,625) teach method for electronic payment

system with issuer control.

Collin (U.S. Patent No. 4,992,646) teaches transaction system of electronic purse

type.

Jones et al. (U.S. Patent No. 5,440,634) teaches electronic purse value transfer

system.

Hjelmvik (U.S. Patent No. 6,431,454) teach method of effecting payment with a

card that includes an electronic purse.

Matsumoto et al. (U.S. Patent No. 6,345,263) teach electronic purse application

system and method thereof.

Nakano et al. (U.S. Patent No. 5,987,438) teach electronic wallet system.

Rankl et al. (U.S. Patent No. 5,534,683) teach multifunctional card having an

electronic purse.

Shiobara et al. (U.S. Patent No. 6,266,653) teach electronic money management.

Teicher (U.S. Patent No. 6,076,075) teach retail unit and payment unit for serving a customer with electronic wallet on purchase and method for executing the same.

This office-action is made **Non-Final**. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571) 270-1374. The examiner can normally be reached on 7:00 AM - 4:30 PM (Monday-Friday); 2nd Friday OFF.
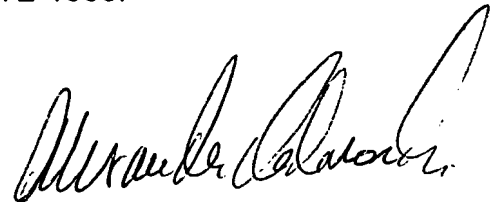
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BKS

ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER